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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN CHAN, NEIL HEPWORTH,
and STEPHANE C. LAVEAU

Appeal 2008-3742
Application 10/622,982¹
Technology Center 2100

Decided:² February 10, 2009

Before JAY P. LUCAS, CAROLYN D. THOMAS, and STEPHEN C. SIU,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed July 17, 2003. The real party in interest is Avaya Technology Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 to 31 and 36 to 49 under authority of 35 U.S.C. § 134. Claims 32 to 35 are withdrawn. (App. Br. § III). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Subsequent to Appellants' filing the appeal, the Examiner indicated in the Examiner Answer (p. 15, top) that claims 11, 27 and 47 would be allowable, removing them from the subject of this appeal. Thus, the claims on appeal are currently: 1 to 10, 12 to 26, 28 to 31, 36 to 46, and 48 to 49.

Appellants' invention relates to a method and device for restricting e-mail or other similar messages to a confined group of recipients from among a larger group, by characteristics of the recipients, or geographic limitations. In the words of the Appellants:

The present invention is directed to a restriction identifier for indicating a subset of recipients having authority to receive and/or otherwise access or redistribute an electronic message. The restriction identifier may indicate that a message recipient may only access the message from specified locations, such as locations internal to a network. The restriction identifier may also indicate that the electronic message has an age limit following either sending or accessing of the message.

(Spec. 3, l. 21 to 4, l. 3)

Claim 1 is exemplary:

1. A method for processing an electronic message, comprising:
receiving a message from a sender, the message comprising at least one recipient to receive the message and including at least one of a restriction identifier, the restriction identifier identifying a subset of

recipients from among a set of possible recipients and an access restriction indicating a subset of points of access from among a set of points of access to access the message;

determining whether each identified at least one recipient is within the subset of recipients corresponding to the restriction identifier; and wherein at least one of the following steps is performed:

(i) when the message comprises the restriction identifier and an identified at least one recipient is not within the subset of recipients, at least one of not providing access to the message to the identified at least one recipient who is not in the subset of recipients and notifying the sender that an identified at least one recipient is not within the subset of recipients; and

(ii) when the message comprises the access restriction and an identified at least one recipient attempts to access the message from a point of access not within the subset of points of access, not providing access to the message to the identified at least one recipient whose point of access is not within the subset of points of access.

PRIOR ART

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Olivier	6,480,885 B1	Nov. 12, 2002
Clarke	2003/0065727 A1	Apr. 3, 2003
Tsuei	6,654,779 B1	Nov. 25, 2003
Canale	5,619,648	Apr. 8, 1997

REJECTIONS

R1: Claims 1, 3, 5 to 8, 10, 11, 13 to 17, 19, 21 to 24, 26, 27, 29 to 31, 36, 37, 39, 41 to 44, 46, 47, and 49 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Olivier.

R2: Claims 2, 4, 18, 20, 38 and 40 stand rejected under 35 U.S.C. § 103(a) for being obvious over Olivier in view of Clarke.

R3: Claims 9, 25 and 45 stand rejected under 35 U.S.C. § 103(a) for being obvious over Olivier in view of Tsuei.

R4: Claims 12, 28 and 48 stand rejected under 35 U.S.C. § 103(a) for being obvious over Olivier in view of Canale.

Groups of Claims:

Claims will be discussed in the order of the rejections. *See* 37 CFR § 41.37(c)(1)(vii). *See also In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002) (“If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.”).

Appellants contend that the claimed subject matter is not anticipated by Olivier, or rendered obvious by Olivier in combination with Clarke, Tsuei or Canale, for failure of the references to teach claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details.

Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm-in-part.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102 and 35 U.S.C. § 103. The issue turns on whether the Olivier reference in particular teaches the restriction identifiers and access restrictions for the messages as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method for restricting the propagation of an electronic message (e.g. e-mail or voicemail) by including a restriction identifier in a portion of the message, which limits the locations from which the message may be accessed, or which limits the time during which it may be accessed, or limits the recipients to a subset of a population, or which contains other types of restrictions. (Spec. p. 3, l. 21 to p. 4, l. 3, quoted above; and p. 6, l. 3) Responsive to the restriction, the message may be tagged by an outgoing server to effectuate the terms of the restriction. (Spec. 5, l. 16).
2. The Olivier patent reference teaches a method for distributing electronic messages (e.g. e-mail or voicemail) (col. 4, ll. 49-58) to a subset of a

population based on the specifications of the sender (col. 5, l. 43) or on the acceptance criteria of the intended receivers. (col. 6, l. 37). The limitations may be geographic (col. 2, l. 19), or based on mutual interests (col. 5, l. 60), or mix criteria of gender, age, zip code etc. (Fig. 9). The system described in the patent is subscription based, where parties join a large group and then address subgroups in their messages, although non-subscribers can also participate by including the restrictions in the message. (Col. 13, l. 43). A subscription can expire, and be optionally renewed. (Col. 14, l. 25).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

"Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) "In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the

public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” *Id.* (internal citations omitted).

The analysis begins with an interpretation of the claims: “[b]oth anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellants’ claims under 35 U.S.C. §§ 102 and 103. The prima facie case is presented on pages 3 to 12 of the Examiner’s Answer. In opposition, Appellants present a number of arguments.

Arguments with respect to the rejection of claims

*1, 3, 5 to 8, 10, 11, 13 to 17, 19, 21 to 24, 26, 27, 29 to 31, 36, 37, 39, 41 to
44, 46, 47, and 49 under 35 U.S.C. § 102 [R1]*

Appellants contend that Examiner erred in rejecting the cited claims under 35 U.S.C. § 102(b). Appellants first argue that “Olivier does not teach any situation where an identified recipient is not within the subset of recipients. At most, the acceptance criteria discussed in Olivier creates a subset of recipients from among a set of possible recipients.” (App. Br. § VII, 2C, para. 5).

Appellants' argument is noted, but as the Examiner points out (Answer 4, middle) the representative claim 1 requires "the restriction identifier identifying a subset of recipients from among a set of possible recipients" which is precisely what Appellants indicate is taught by Olivier. The Examiner further points out that the recipient acceptance criteria results in identified recipients not being within the set of actual recipients, as they have refused the message. Thus, we find that Appellants' argument is not considered convincing in demonstrating error by the Examiner.

Appellants next argue that "Olivier does not distinguish between which of the matching *subscriber's devices* receives the e-mail let alone specify that the matching subscriber cannot access the message at some of that subscriber's message retrieval nodes." (App. Br. § VII, 2C, para. 7). Olivier points out restrictions based on zip code (Fig. 9) and other geographic limitations. (Col. 2, ll. 17-25). The Examiner has read the access restrictions to some points of access on the geographic limitations of Olivier. No mention is made in the claim of whether the intended recipient has multiple receiving devices, in or out of the intended geographic limitation. Therefore, we find no error in the Examiner's application of the art on this point.

Appellants further argue, with respect to claim 16, that Olivier fails to describe tagging a message with a restriction identifier that will negatively restrict access to the message. (App. Br. § VII, 2D, para. 1). The Examiner points to Figure 9 and column 12, lines 57 to 65 of Olivier, where limitations have been added as tags to the message. We agree with the Examiner that

“negatively restricts” is not a claimed element, and do not find error in the rejection on this point.

With regard to claims 10, 26, and 46, Appellants argue that Olivier teaches an age expiration on the subscription of the user to the service, but not on the age of the message. (App. Br. § VII, 2F, para. 1). The Examiner has argued they are the same, but we find that to be mistaken. Olivier does not teach the age restriction of the message itself as claimed, and therefore, we do not support the rejection of claims 10, 26 and 46 under 35 U.S.C. § 102 over the Olivier teaching.

*Arguments with respect to the rejection
of claims
2, 4, 18, 20, 38, and 40
under 35 U.S.C. § 103 [R2]*

Appellants have not argued the rejection of these claims 2, 4, 18, 20, 38 and 40 for being obvious over Olivier in view of Clarke. The rejection is thus affirmed *pro forma*.

*Arguments with respect to the rejection
of claims
9, 25, and 45 and
12, 28, and 48
under 35 U.S.C. § 103 [R3, R4]*

Appellants’ arguments with respect to the rejections of the noted claims under 35 U.S.C. § 103 for being obvious over Olivier and respectively Tsuei and Canale are based on issues discussed above with respect to alleged deficiencies in the Olivier reference. (*See*, for example,

App. Br. § VII, 3, para. 3). As we do not support these alleged deficiencies in Olivier, we do not find error in the rejections under 35 U.S.C. § 103.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 10, 26 and 46. However, we do not find error in the rejections of claims 1 to 9, 12 to 25, 28 to 31, 36 to 45, and 48 to 49.

DECISION

The Examiner's rejection under 35 U.S.C. § 102 of claims 10, 26 and 46 is Reversed. The rejections [R1, R2, R3 and R4] of claims 1 to 9, 12 to 25, 28 to 31, 36 to 45, and 48 to 49 respectively are Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED – IN - PART

msc

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